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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/194,261      | 05/13/1999  | Otto Schallner       | MO-4908/LEA3        | 2994             |

7590

07/03/2002

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| EXAMINER |
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SAEED, KAMAL A

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1626

DATE MAILED: 07/03/2002 13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/194,261

Applicant(s)

SCHALLNER ET AL.

Examiner

Kamal A Saeed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on communication filed on 04/17/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,9 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Claims 7 and 10-12 have been cancelled. Claims 1-6, 8, 9 and 13 are pending in this application.

The examiners Amendment is withdrawn because the claims are found to be not allowable.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-6, 8, 9 and 13 are rejected under 35 U.S.C. 102 (a) as being anticipated by Daum et al., US 5,057,144.

Daum et al., teach sulphonylaminocarbonyl triazolinones that read in the instant claims when **R**<sup>1</sup> is H, **A** represents a single bond, **R**<sup>2</sup> is optionally substituted alkyl, alkylthio, **R**<sup>3</sup> is triazolinone, **n** is 0 or 2, **R**<sup>4</sup> is H, hydroxyl, amino, cyano, alkoxy, alkylamino, dialkylamino, C<sub>3</sub>.

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C<sub>6</sub> cycloalkyl, **R**<sup>5</sup> is H, hydroxyl, mercapto, amino, C, cyano, alkoxy, alkylamino, dialkylamino, C<sub>1</sub>-C<sub>4</sub> alkyl and **Q** is O. See abstract and columns 9, 13, and 17.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daum et al., US 5,057,144.

Applicants claim substituted amino(thio)carbonyl compounds having generic formula shown in claim 1, wherein **R**<sup>1</sup> is H, **A** represents a single bond, **R**<sup>2</sup> is optionally substituted alkyl, alkylthio, **R**<sup>3</sup> is triazolinone, **n** is 0 or 2, **R**<sup>4</sup> is H, hydroxyl, amino, cyano, alkoxy, alkylamino, dialkylamino, C<sub>3</sub>-C<sub>6</sub> cycloalkyl, **R**<sup>5</sup> is H, hydroxyl, mercapto, amino, C, cyano, alkoxy, alkylamino, dialkylamino, C<sub>1</sub>-C<sub>4</sub> alkyl and **Q** is O.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Daum et al., teach sulphonylaminocarbonyl triazolinones that are analogs of the instant compounds wherein **R**<sup>2</sup> is optionally substituted alkyl.

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The only difference between the compounds of Daum et al., and the claimed compounds is that applicants are claiming alkyl instead of hydrogen at positions **R**<sup>2</sup>.

*Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)*

However, alkyl and H are art recognized equivalents. In re Wood, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and In re Lohr, 137 U.S.P.Q. 548, 549 (C.C.P.A. 1963). Therefore, it would have been prima facie obvious to one having ordinary skill in the art at the time the invention was made to substitute alkyl for H, in the compounds of Daum et al. The motivation to make the claimed compounds derives from the expectation that structurally similar compounds are generally expected to have similar biological and chemical properties. In re Gyurik, 596 F. 2d 1012, 201 USPQ 552 (CCPA 1979).

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal Saeed whose telephone number is (703) 308-4592. The examiner can normally be reached on Monday-Friday from 8:00 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308 4537. The unofficial fax phone for this group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate the Header (upper right) "Official" for papers that are to be entered into the file, and " Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

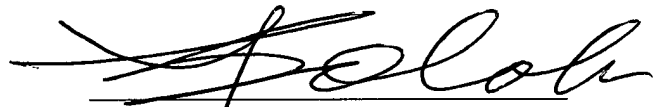
Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet

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e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.

Kamal Saeed, Ph.D.,  
July 1, 2002

A handwritten signature in black ink, appearing to read 'Sofola', with a horizontal line drawn underneath it.

Taofiq Sofola, Ph.D.,  
Primary Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1